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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,164	07/08/2003	Satoshi Kawase	JP9-1999-0099US3	8607

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EXAMINER
ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 April 2006</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>5 – 7, 9 and 14 – 16</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>5 – 7, 9 and 14 – 16</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/15/2006</u>. *ØL*

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   Claims 5 – 7, 9 and 14 – 16 are presented for examination.

Double Patenting

2.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection
is appropriate where the conflicting claims are not identical, but at least one examined
application claim is not patentably distinct from the reference claim(s) because the examined
application claim is either anticipated by, or would have been obvious over, the reference
·claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re
Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re
Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163
USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may
be used to overcome an actual or provisional rejection based on a nonstatutory double patenting
ground provided the conflicting application or patent either is shown to be commonly owned
with this application, or claims an invention made as a result of activities undertaken within the
scope of a joint research agreement.
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR
3.73(b).

3.   Claims 5 – 7, 9 and 14 – 16 are rejected on the ground of nonstatutory obviousness-type

double patenting as being unpatentable over claims 1 - 8 of U.S. Patent No. 7092991. Although

the conflicting claims are not identical, they are not patentably distinct from each other because

7092991 has all the limitations of the pending application 10/615164 with further descriptions of

claim language.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   Claims 5 – 7, 9 and 14 – 16 are rejected under 35 U.S.C. 102(e) as being anticipated by

U.S. Patent No. 7092991.

6.   Referencing claim 5, as closely interpreted by the Examiner, 7092991 teaches an

information terminal support server which supports collaboration of a browser loaded on a

customer-side information terminal and a browser loaded on an agent-side information terminal,

the information support server comprising:

7.   (a) a rule definition part including a condition setting part and a command setting part,

(e.g., Claims 1 – 8);

8.   (b) a rule control manager for monitoring, at the information terminal server, HTTP

messages sent in response to customer-side browser requests, (e.g., Claims 1 – 8);

9.   (c) an HTTP checker, determining whether or not said HTTP messages agree with a

condition of said condition setting part of said rule definition part, (e.g., Claims 1 – 8);

10. (d) an HTTP editor, editing contents of said HTTP messages according to contents of said command setting part of said rule definition part, when said HTTP messages agree with a predetermined condition, (e.g., Claims 1 – 8);

11. (e) customer cache storing of said HTTP messages in an unedited form sent to the browser on the customer-side information terminal, (e.g., Claims 1 – 8); and

12. (f) agent cache storing of said HTTP messages in an edited form sent to the browser on the agent-side information terminal, (e.g., Claims 1 – 8).

13. Referencing claim 6, as closely interpreted by the Examiner, 7092991 teaches editing is carried out to insert a command for a client program loaded on the agent-side information terminal, (e.g., Claims 1 – 8).

14. Referencing claim 7, as closely interpreted by the Examiner, 7092991 teaches said command is one of "form submit prohibition", "form alteration prohibition", "concealment of specific form" or "concealment of specific field, (e.g., Claims 1 – 8).

15. Claims 9 and 14 – 16 are rejected for similar reasons as stated above.

SECOND DETAILED ACTION

Claim Rejections - 35 USC § 103

16.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

17.   Claims 5 – 7, 9 and 14 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kohler (6192396) in view of Beck et al. (5903723) in further view of Brown et al.

(6073137).

18.   Referencing claim 5, as closely interpreted by the Examiner, Kohler teaches an

information terminal support server which supports collaboration of a browser loaded on a

customer-side information terminal and a browser loaded on an agent-side information terminal,

the information support server comprising:

19.   a rule definition part including a condition setting part and a command setting part, (e.g.,

col. 5 et seq., Figures 6 – 9, setting privileges, to users or managers that can be considered

agents, on who can view specific sections of the email);

20.   a rule control manager for monitoring, at the information terminal server, messages sent

in response to customer-side browser requests, (e.g., col. 5, lines 31 – 48, *"E-mail server 35*

manages...");

21.   an checker, determining whether or not said messages agree with a condition of said

condition setting part of said rule definition part, (e.g., col. 5 et seq., Figures 6 – 9, setting

privileges on who can view specific sections of the email, when checked it is edited for that

specific viewer therefore it is the email program also "checks" the email);

22.   an editor, editing contents of said messages according to contents of said command

setting part of said rule definition part, when said messages agree with a predetermined

condition, (e.g., col. 5 et seq., Figures 6 – 9, setting privileges on who can view specific sections

of the email);

23.   customer storing of said messages in an unedited form sent to the browser on the

customer-side information terminal, (e.g., col. 5 et seq., Figures 6 – 9, it is well known in the art

that any email user can send an email to themselves, example, TO:, CC:, or BCC:, furthermore,

storing emails on a server is well known); and

24.   agent storing of said messages in an edited form sent to the browser on the agent-side

information terminal, (e.g., col. 5 et seq., Figures 6 – 9, storing emails on a server is well

known).

25.   Kohler does not specifically teach the specific use of HTTP messages and does not

specifically teach the use of a cache storing of a message.

26.   Beck teaches the utilization of HTTP messages for emails using browsers, (e.g., col. 12,

line 34 et seq.). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine Beck with Kohler because providing an HTTP-only e-mail

system, provided for e-mail services utilizing only HTTP, would give the need for no necessity

of accessing a separate e-mail application in addition to the HTTP web-browser being utilized.

27.   Brown teaches the caching of e-mail for all of its users, (e.g., col. 6, lines 5 – 32). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to

combine Brown with the combine system of Kohler and Beck because caching information from

the internet or any network give a user of the system faster access to the requested information.

Furthermore, if there is local caching, it allows the user access to the information without further

need of the network to which they are connected thereto.

28.   Referencing claim 6, as closely interpreted by the Examiner, Kohler teaches editing is

carried out to insert a command for a client program loaded on the agent-side information

terminal, (e.g., col. 5 et seq., Figures 6 – 9, setting privileges on who can view specific sections

of the email).

29.   Referencing claim 7, as closely interpreted by the Examiner, Kohler teaches said

command is one of "form submit prohibition", "form alteration prohibition", "concealment of

specific form" or "concealment of specific field", (e.g., col. 5 et seq., Figures 6 – 9, setting

privileges on who can view specific sections of the email).

30.   Claims 9 and 14 – 16 are rejected for similar reasons as stated above.

Response to Arguments

31.   Applicant's arguments, see page 7, filed 04/27/2006, with respect to the rejection(s) of

claim(s) 5 – 7, 9 and 14 – 16 under 102(e) rejection have been fully considered and are

persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration,

a new ground(s) of rejection is made in view of Kohler, Beck and Brown as stated above.

32.   Applicant is advised to contact the Examiner to further prosecution with claim

amendment ideas that could put the application into condition for allowance.

Conclusion

33.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

34.   a.   Chan et al. U.S. Patent No. 6697844 discloses Internet browsing using cache-

based compaction.

35.   b.   Kedem U.S. Patent No. 6389511 discloses On-line data verification and repair in

redundant storage system.

36.   c.   Kuzma U.S. Patent No. 5781901 discloses Transmitting electronic mail

attachment over a network using a e-mail page.

37.   d.   Shaw et al. U.S. Patent No. 6816887 discloses Method and apparatus for sending

private messages within a single electronic message.

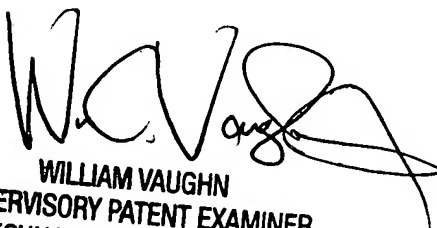38.   e.   Crow et al. U.S. Patent No. 6393526 discloses Shared cache parsing and pre-

fetch.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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